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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/646,192
Filing Date: August 21, 2003
Appellant(s): WATSON ET AL.

Steve Munson
Reg. No. 47,812
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 7, 2007 appealing from the Office action mailed April 21, 2006 and November 2, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0056118 A1	HUNTER ET AL.	05-2002
6,184,877 B1	DODSON ET AL.	02-2001
6,757,909 B1	MARUO ET AL.	06-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 4-10,12-16, 18-35, 37, 41-42, 52-59, 61, 63, 72-77, 79-100 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al. (US 2002/0056118).

Regarding claim 4, the claimed method of broadcasting a movie to a set top box is met by Hunter's disclosure as follow:

"a content provider broadcasting movie data to a set top box, the content of the movie data being selected by the content provider" is met by the content provider and data transmission system broadcasting movie data to the user station, the content of the movie data automatically selected by the content provider and/or system operator (par. 0139);

"permitting automatic storage of the movie data broadcast from the content provider onto the set top box" is met by the automatically download the movie data from the content provider and data transmission provider onto storage module of the user station (par. 0139);

"permitting assembling the movie data in the set top terminal to form at least one full movie and associated metadata" is broadly met by assembling movie data in the user terminal to form a movie associated with movie title, category, header information, etc. (par. 0074-par. 0076; par. 0139.);

Hunter also discloses the graphical user interface alerts the customer that the recording are available by a cue such as "You've got flicks" (paragraph 0139) or the movie is remained in the storage for a period, say one week, regardless of "traffic" through the storage (paragraph 0144, 23-31). Thus, the metadata (information associated with the movie data) is inherently analyzed to determine when to make the movie available for viewing so that the cue such as "you've got Flicks" is displayed at a predetermined time (i.e. when the recording is available) or the movie remains in

Art Unit: 2623

storage at predetermined time (e.g. one week) regarding of the “traffic” through the storage;

“permitting viewing of the movie in response to a user’s selection of the movie” is met by user select a movie title to view the movie associated with the selected title (par. 0128, par. 0151).

Regarding claim 5, Hunter further discloses permitting viewing occurs upon agreement to charge the user a fee for viewing the selected movie (par. 0128, lines 30-43).

Regarding claim 6, Hunter further discloses the movies are available to the customer over a period of time (par. 0141), and the movie remains in storage for a minimum period of time, say one week, regardless of “traffic” through the storage device (par. 0144). Inherently, associated metadata comprises information such as time stamp which determine begin and end dates for permitted movie viewing (e.g. begin date is begin of “one week” and the end date is the end of “one week”).

Regarding claim 7, Hunter further discloses the movie selected by the user is available for viewing for a limited of time (e.g. 24 hour – par. 0161)

Regarding claim 8, Hunter further discloses the movie selected by the user is available for viewing for a limited number of times (e.g. three plays – par. 0161).

Regarding claim 9, Hunter further discloses “re broadcasting movie data previously broadcast to ensure that the entire movie is received by the set top box” (e.g. release movies are transmitted every 30 minutes from 5:30 pm to 8:30 pm, and several other times daily – paragraphs 0119, 0139, 0213-0216). As a result, the set top box (user station) receives entire movie.

Regarding claim 10, the limitations correspond to the limitations of claim 4 are analyzed as discussed in the rejection of claim 4. Hunter further discloses the content provider and/or system operator automatically record the movie into storage module of the user station. The graphical user interface alerts the customer that the recordings are available (par. 0139) or overwrite the less likely to be purchased movies ahead of those recording, or certain new release movies may be designated (by the content provider/operator) to remain in storage for a minimum period of time, say one week, regardless of the “traffic” through the storage (paragraph 0144). Inherently, the selected movie is made available for viewing by the user at a time predetermined by the content provider (i.e. when recording is available or when the movie is not deleted from the storage), the selected movie having previously been stored on the set top box (the movies is stored in storage of set top box).

Hunter further discloses the movies are available to the customer over a period of time before they are overwritten or deleted, the content provider controls the downloading of movie into the set top box (par. 0139, par. 0141; par. 0144, par. 0147). Thus, the movie data representing one or more movie stored in the set top box is

effectively removed at the time determined by the content provider (e.g. when the new movie is downloaded or when the period of time designated for certain new release movie to remain is expired).

Regarding claim 12, Hunter further discloses the movie data comprises audio and video to from a movie and associated metadata, wherein the metadata indicates time predetermined (scheduling data or designated time to remain to the movie regardless of traffic) by the content provider to make the movie available for viewing by the user (par. 0065, 0144, lines 23-31).

Regarding claim 13, Hunter further discloses the movie is a new release (par. 0013) and the claims feature of “the time predetermined by the content provider to permit viewing by the use is an official release date for the new release” is broadly met by the time/date indicates the availability of the recorded movies for playback– par. 0013).

Regarding claim 14, Hunter further discloses the movie data is broadcast to the set top box using standard files transfer protocols (e.g. MPEG-2, par. 0121).

Regarding claims 15-16, the additional limitation as claimed corresponds to the additional limitation as claimed in claims 9, 5 respectively, and are analyzed as discussed with respect to the rejection of claims 9 and 5.

Regarding claim 18, Hunter discloses a method of broadcasting movie data to a set top box (user station) for storage and subsequently viewing, the method comprising:

selectively broadcast data wirelessly from a content provider to a set top box (movie data are selected and automatically downloaded to storage module of user station by content provider and/or system operator via wireless network i.e. satellite – par. 0139, figure 11);

content provider and/or system operator alerts the customer that the recordings are available (par. 0139, par. 0147) or certain new release movie is designated to remain in storage for minimum period of time regardless of traffic through the storage (paragraph 0144, lines 23-31) reads on the claimed feature of “remotely controlling when to make data available for viewing by the user”;

content provider and/or system operator control when to transmit new movie or controls period of time the movie data that the movie is designated to remain in the storage before they are overwritten or deleted (par. 0139, par. 0144, par. 0147) reads on the claimed feature of “remotely controlling when to remove that data from the set top box.”

Regarding claim 19, the claimed feature of “permitting the user to select when to view selected data during an available access time, the user selectively viewing the data one on one or more television sets, and the set top box being a unit separate from the one or more television set” is broadly met by the user select a recorded movie on the list to view on television set (32) when the movie is available (not been removed/deleted)

wherein the user station (228) being separate from the television (32) – figure 11, par. 0013, paragraph 0151, paragraphs 0139, 0144).

Regarding claim 20, Hunter further discloses wherein payment for a permitted viewing of the data is made by the user through a separate telephone line (telephone line 38-figure 11, par. 0151).

Regarding claim 21, Hunter further discloses selectively broadcasting data permits the content provider to determine the data to be broadcast wirelessly to the set top box (content provider/data transmission provider selects data to be broadcast over satellite according to the movie preferences of the customer – figure 11, par. 0139-par. 0142).

Regarding claim 22, Hunter further discloses the data is broadcast by encoding data onto standard broadcast television signals (e.g. MPEG-2 – par. 0169).

Regarding claim 23, Hunter teaches a method of content management for a remote hardware device (user station), the method comprising:

collecting content to be transmitted to a remote hardware device (collecting movie data such as new release movies, very popular movie, user interest movie, to be transmitted to the user station – paragraphs 0012- 0013, 0139);

generating metadata specifying various properties of the content (generating header information, price, scheduling data, designated time for movie to be remain in the storage, catalogs, etc. for the movie – par. 013, 0144, lines 23-31 figure 11);

associating the metadata with the content (associating scheduling data, price, designated time for movie to remain in the storage, etc. with the movie – figures 11-12, par. 0013-0014, paragraph 0144, lines 23-31);

transmitting the content and its associated metadata to the remote hardware device (transmitting the movie data and its price, scheduling data, etc. to the user station – figures 11, 15, par. 0061, paragraphs 0139, 0144, lines 23-31, paragraph 0145);

permitting automatic storage of data received at the remote device (automatically download the movie data- par. 0139);

providing software for operating on the remote hardware device to process the metadata and manage the content according to its associated metadata (providing software for operating on the user station to process metadata such as scheduling data, price data, header information, etc. so that the movie associated with the selected data to be playback/recorded, the movie is selected to received based on its ID header information, or movie is selected to remain in storage based on designated time regardless of traffic through the storage – par. 0065-par. 0075, par. 0139, paragraph 0144, lines 23-31).

Regarding claim 24, Hunter discloses the customer is alerted that the recordings are available (par. 0139). The movie data is recorded with a limited date (par. 0161, paragraph 0144, lines 23-31). Inherently, the metadata comprises information indicating when to make content available to the viewer and when to remove content from the remote hardware device so that the cue is displayed when the recording is available and when the content is oldest content, less likely to be purchased content, or the designated time to remain the content in storage is expired.

Regarding claim 25, the additional limitation as claimed corresponds to the additional limitation as claimed in claim 9, and are analyzed as discussed with respect to the rejection of claim 9.

Regarding claim 26, Hunter teaches a method for providing movies available for purchase or rental directly to remote viewers through broadcast communication (figure 11), the method comprising:

- providing a view with a set top box (228), the set top box having a hard drive (230) for storing a plurality of movies (figure 11 and par. 0138);

- broadcasting movie data to the set top box and allowing movie data to accumulate on the hard drive (figure 11, par. 0138-par. 0139);

- providing software resident on the set top box, the software being programmed to: automatically store the movie data broadcast to the set top box (figure 11, par. 0139, par. 0083);

assembling the movie data broadcast into a plurality of viewable movies and associated metadata (forming the list of available movies so that the user can select an associated information to view the movie - par. 0083-par. 0089, par. 0148);

analyzing the metadata to determine when a movie should be made available (analyzing header information to indicate alerts to customer that the recordings are available – par. 0139, par. 0147, par. 0161, or designated time to remain content in the storage (paragraph 0144, lines 23-31). Also see discussion in rejection of claim 1);

allowing the user to select the available movie when available (par. 0147-par. 0151).

Regarding claim 27, Hunter further discloses the movies are available for a predetermined limited time (e.g. 24 hours, one week, etc.) and thereafter are essentially removed by the broadcaster (par. 0144, par. 0161).

Regarding claim 28, Hunter further discloses the movies are encrypted thereby to limit the availability in at least one of the following: being copied multiple times, being viewed more than once, or being viewed or copied other than when predetermined criteria are met (par. 0138, lines 20-21; par. 0150, par. 0163).

Regarding claim 29, the additional limitation as claimed corresponds to the additional limitation as claimed in claim 22, and are analyzed as discussed with respect to the rejection of claim 22.

Regarding claim 30, the limitations of the method of creating a digital home movie library correspond to the limitations of the method for broadcasting movies in claim 10, and are analyzed as discussed with respect to the rejection of claim 10. Furthermore, Hunter discloses broadcasting the movies using satellite (figure 11). Thus, the provider broadcast the movies to plurality of set top boxes. Hunter further discloses providing a plurality of movies (par. 0139). Thus, a plurality of full movies is formed.

Regarding claims 31-35, the limitations as claimed correspond to the limitations as claimed in claims 27-29,20-21 respectively, and are analyzed as discussed with respect to the rejections of claims 27-29 and 20-21.

Regarding claims 37, the method as claimed is broader in scope than the method as claimed in claim 26 wherein the limitation of "official release date for the movie" corresponds to the available date of the movie in claim 26, and therefore, are analyzed as discussed in the rejection of claim 26.

Regarding claim 41, Hunter further discloses the system reads on the claimed limitations as follow:

antenna 24 and tuner(s) in the user station (228) for receiving broadcast signal – figure 11, paragraphs 0128-0129- read on the claimed feature of "an antenna and tuner for receiving broadcast signal";

storage module 230 (figure 11, par. 0128-0138) reads on the claimed "a hard disk drive..." (also see discussion in the rejection of claim 23);

CPU/CODEC (figures 2, 11, par. 0128) reads on the claimed feature of "a processor...." wherein the claimed "control condition derived from the metadata" is met by code keys for decryption the encoded movies, ID header information for determining the movie is available or interested to the user decrypting the movies once the viewer is authorized to access the movie (par. 0128-0139, par. 0144).

Regarding claim 42, Hunter further discloses a modem (figures 4, 11) permit electronic billing of the user for access of the library.

Regarding claims 52-59, the limitations as claimed correspond to the limitations as claimed in claims 4-5, 7-8, 10, 15-16, 18 and are analyzed as discussed with respect to the rejection of claims 4-5, 7-8, 10, 15-16, 18.

Regarding claims 61 and 63, the additional limitations as claimed correspond to the limitations as claimed in claims 56, 54, and are analyzed as discussed with respect to the rejection of claims 56, 54, wherein the claim antenna is met by antenna 24 – figure 11.

Regarding claims 72-75, the limitations as claimed correspond to the limitations as claimed in claims 4-5, 7, 9, and are analyzed as discussed with respect to the rejection of claims 4-5, 7, 9.

Regarding claim 76, Hunter further discloses modem (87- figure 4 or billing module 240/Internet access interface 235 – figure 11) reads on the claimed modem, wherein the feature of “periodical permit contact with the content provider” is met by video distribution system operator periodically receives viewed-content information for billing (par. 0103, lines 16-19).

Regarding claim 77, Hunter further discloses information passed between the content provider and the set top via the modem includes at least one of a user’s viewing/rental history, access information used for billing purposes, keys used to decrypt videos (figures 10-11, par. 0103).

Regarding claim 79, Hunter further discloses the hard drive in the set top box stored pay per view program and the CPU of the set top box controls the operation of the hard drive (figures 4, 11, par. 0128) broadly reads on the claimed feature of “the hard drive is physically mated with the set top box structure for security purposes thereby rendering it useless for its intended storage purpose if removed for intended use apart from the set top box”

Regarding claim 80, Hunter further discloses broadcast movies to a set top box for storage and subsequent viewing the movies (0128), 0138-0139), wherein the videos stored on the set top box are encrypted (paragraphs 0128,0138,0150), and upon selection of a video to view and satisfaction of business rules (e.g. pay to view video), the set top box permits the video to be decrypted and played (page 9, left col. lines 8-13).

Regarding claim 81, Hunter discloses the movies are periodically transmitted to user station for and are stored in a storage device (par. 0128). The code keys A, B, C that used to decrypt and playback the movie (par. 0079-par. 0083). Since these code keys are transmitted and stored at the user station, the set top box (user station) is not necessarily connected to the content provider after the video is stored, and prior to allowing a video to be viewed, the video being capable of independent decryption by electronic keys (code keys A,B,C) on the set top box along with the current account status.

Regarding claim 82, Hunter further discloses logging a decryption of a movie and using the log to determined a user's bill (par. 0089-par. 0096; par. 0061).

Regarding claim 83, Hunter discloses the content provider controls when to download the movies and associated information to the set top box at receiving side (paragraph 0139); the movies is stored in storage device until the content provider controls to

download new movies to the storage device. Certain movies in high demand within the customer primary areas of interest may be designated to remain in storage for a minimum period of time, say one week, regardless of the "traffic" through storage device (paragraph 0144). Thus, the content provider inherently transmits metadata (i.e. information in new movie to be downloaded or information used to maintain the movie in storage for a period of time, say one week, regardless of traffic through the storage) to a set top box (i.e. set top box 228- figure 11), the metadata being associated with content previously stored on the set top box, the metadata being utilized by the set top box to delete the content (information is used to delete oldest content, delete content that less likely to be purchased, or information to identify content to be deleted after a minimum period of time, say one week, regardless of the "traffic" through the storage).

Regarding claim 84, Hunter further discloses the metadata comprises a date (e.g. after minimum period of time, say one week, for certain movie that remain in the storage with designated time period of one week regardless of the traffic through the storage – paragraph 0144, lines 23-31) or the date the new movie is transmitted to replace to oldest movie stored in the storage at the set top box (paragraphs 0139, 0144).

Regarding claim 85, Hunter further discloses the content previously stored on the set top box is transmitted remotely from the content provider (paragraph 0139, figure 11).

Regarding claim 86, the additional limitations is broader than the additional limitations as claimed in claim 81, and therefore, are analyzed as discussed in claim 81.

Regarding claim 87, Hunter further discloses deletion of content is independent from making room for new content as a result of available disk space (overwrite the less likely to be purchased movies **ahead** of those recordings (independent of making room) which, by analysis at module 340, show more promise of being viewed by the customer – paragraph 0144, lines 23-27), or certain new release movies is designated to remain in the storage for a minimum period of time, say one week, regardless of the “traffic” through storage module – paragraph 0144, lines 28-32. As a result, the content is deleted regardless of making room for new content as a result of availability disk space (regardless of “traffic” through the storage).

Regarding claim 88, Hunter discloses the content provider controls when to download the movies and associated information to the set top box at receiving side (paragraph 0139); the movies is stored in storage device until the content provider controls to download new movies to the storage device. Certain movies in high demand within the customer primary areas of interest may be designated to remain in storage for a minimum period of time, say one week, regardless of the “traffic” through storage device (paragraph 0144). Thus, the method of remotely deleting content from a set top box (deleting content in the set top box by content provider or operator) inherently comprising:

composing an instruction to delete specific content previously stored on a set top box (e.g. composing designated time to remain the movie of the set top box, composing information for new content to be downloaded – paragraphs 0139, 0144); and transmitting metadata including the instruction to delete specific content to the set top box, the set top box having logic therein that interprets the instruction and deletes the previously stored content referenced in the instruction (transmitting associated information including designated time of certain movie to store in the storage regardless of the traffic, and as a result, the certain content is deleted based on interpreted designated time regardless of the “traffic” through the storage.

Regarding claims 89-90, the additional limitations as claimed correspond to the additional limitations as claimed in claims 85-86, and are analyzed as discussed with respect to the rejection of claims 85-86.

Regarding claims 91-94, the limitations as claimed correspond to the limitations as claimed in claims 83-86, wherein the limitation “to delete the content” correspond to “to make the content unavailable to a user”, and are analyzed as discussed with respect to the rejection of claims 83-86.

Regarding claim 95, Hunter discloses a method for displaying available movies stores on a set top box (paragraph 0151), comprising:

receiving a plurality of movies from a content provider (paragraph 0139);

receiving a plurality of sets of metadata, each of the sets of metadata being associated with one of the plurality of the movies (receiving ID header information of the movie, title of the movie, designated time to remain certain movie in the storage regardless of the traffic, catalog of the movie, type of content, etc. – paragraphs 0139 – 0148);

Hunter further discloses identifying the selected movies (i.e. popular movies, new release movie, user interested movies,) to be downloaded to the storage, provide a cue to alert user that certain movie is available so the user can selected to watch – paragraph 0139, or identifying the oldest movie, less likely to be purchased movies to removed/deleted from the storage, or identifying certain movie to remain in storage using designated time period (paragraph 0144), listing menu of available movies on the screen (paragraph 0151). Inherently, each of the sets of metadata must be analyzed to identify the movie to be downloaded (i.e. popular movies), the available movies to be displayed for viewing in a user interface associated with the set top box so the user can select the movie to watch.

Regarding claims 96-97, Hunter discloses the pre-determined criteria is a date on which the set top box is authorized to display the movie (e.g. the date or time within one week period designated to remain the certain movie in the storage regardless of the traffic through the storage- paragraph 0144, lines 23-32. Inherently, during this period, the set top box is authorized to select the movie to display).

Regarding claim 98, the limitations that correspond to the limitations of claim 95 are analyzed as discussed with respect to the rejection of claim 95. Hunter further discloses selecting and providing popular movies, user interested movies, new release movies, etc. with associated data such as designated time period to remain certain movie in the storage device (paragraphs 0139 –0148). Thus, a pre-determined criteria and metadata (e.g. associated information of popular movie, new release movie, designated time to remain certain movie in storage, etc.) is established and composed so the desired movie is identified and displayed;

transmitting content associated with the metadata to the set top box (e.g. transmitting new release movie, popular movie, user interested movies) to the set top box (figure 11, paragraphs 0139 –0148).

Regarding claims 99-100, the limitations as claimed correspond to the limitations as claimed in claims 96-97, and are analyzed as discussed with respect to the rejection of claims 96-97.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 2002/0056118) as applied to claim 10 above.

Regarding claim 11, Hunter discloses a method as discussed in claim 10. Hunter further discloses the broadcast provider controls downloading of movie into the storage device, and controls the available time of the downloaded movies (par. 0139). A skilled person in the art can select any time before making the stored movie available depend on the capability and characteristics of the transmission medium, device limitations, times, operator's desire. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hunter to include storing the movie to be any time period such as at least one day, and preferably about a week, before making the movie available for viewing so long as the time desired is limited to the capability and/or characteristics of the transmission medium and/or device limitations and/or operator desire to improve efficiency of movie services.

5. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 2002/0056118) as applied to claim 76 above, and further in view of Dodson et al. (US 6,184,877).

Regarding claim 78, Hunter discloses a system as discussed in the rejection of claim 75. Hunter further discloses a processor (CPU) plays a video and reacts to signals from a remote control (figures 4, 11, par. 0072-par. 0076), and activity modem (modem 87,

figure 4, or modem 650 –figure 23). However, Hunter does not specifically disclose simultaneously plays a video and reacts to signal from a remote control.

Dodson discloses the processor (e.g. controller) simultaneously plays a video (video being displayed on the TV) and reacts to signals from a remote control (remote control 206), and modem activity (internet interface 106) – see figures 1, 1-8, col. 2, line 46-col. 3, line 28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hunter to incorporate the teaching as taught by Dodson in order to immediately provide additional information to the user (col. 1, lines 40-55), and allow user to simultaneously watch the program and additional information on the same screen.

6. Claims 43- 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 2002/0056118) and in view of Maruo (US 6,757,909).

Regarding claim 43, the limitations that correspond to the limitations of claim 41, are analyzed as discussed with respect to the rejection of claim 41. Hunter further discloses the user pay to access the recorded movie (par. 0139). However Hunter does not specifically disclose a smart card secured to a circuit board of the receiver, the smart card facilitating a dedicated use of the receiver with a designated user.

Maruo disclose a smart card 525 is inserted/coupled into interface card 530 of the receiver (col. 8, lines 47-61; col. 11, lines 10-22) reads on the claimed feature of "a smart card secured to a circuit board of the receiver". The smart card stores the information needed by a cable system operator or digital broadcast system operator to bill a subscriber for services used by the subscriber. Typically, smart card also implements a scramble key provided by the MSO that is used to descramble digital broadcast signal (col. 8, lines 47-61). Necessarily, the smart card facilitates a dedicated use of the receiver with a designated user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hunter to use the teaching as taught by Maruo in order to improve convenience for user to pay the bill and reduce unauthorized user to access pay per view program.

Regarding claim 44, the additional limitation as claimed corresponds to the additional limitation as claimed in claim 42, and is analyzed as discussed with respect to the rejection of claim 42.

Regarding claim 45, Maruo further disclose the intelligent transceiver (reads on the claimed set top box) comprises a tuner for operation with a monitor (TV – figure 6). The tuner receives broadcast signal via a wireless transmission (e.g. a satellite broadcast – col. 7, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made that an antenna (for receiving signal from wireless

transmission) is a part of a set top box in order to simplify network connection and reduce the cost of the cable between the antenna and the tuner in the set top box.

Regarding claim 46, Hunter in view of Maruo discloses a system as discussed in the rejection of claim 45. Maruo further disclose the smart card is coupled in different manners to the transceiver reads on the claimed feature of "an integral fastening of an active component of a smart card to a circuit board of the set top box thereby impede removal, and enhance the security of the set top box.

Regarding claim 47, Maruo further discloses POD 520 for inserting a smart card (col. 11, lines 17-20, figure 5B) reads on the claimed feature of "a secondary external smart card slot for use with another smart card in case the system becomes compromised."

Regarding claim 48, Maruo further discloses the smart card is coupled with the intelligent transceiver in different manners (col. 8, lines 55-61). It is obvious to one of ordinary skill in the art that the smart card is fastened to a main board of the set top box with epoxy in order to improve security of the smart card, and furthermore, reduce unauthorized user to access the data.

(10) Response to Argument

1. The Examiner Incorrectly Relies Upon Inherency As The Primary Basis For His Claim Rejection Under 35 U.S.C § 102.

Appellant argues the Examiner has not established that the missing descriptive matter is necessarily present in Hunter; the Examiner has also not established that the missing descriptive matter would be recognized by one of ordinary skill because Hunter does not teach, for example, how to determine when to remove a movie from storage or how to maintain a certain movie in storage regardless of the traffic through storage (page 12). This argument is respectfully traversed.

It is note that the specific language of how to determine when to remove a movie from storage or how to maintain a certain movie in storage regardless of the traffic through storage are not recited in the claims; the claim, for example, claim 1 recites "permitting analysis of the metadata to determine when to make the movie available for viewing" or claim 10 recites "effectively removal of the movie data representing one or more movies stored on the set top box at a time determined by the content provider". Hunter discloses the movies comprise information such as title, time, rating, type, etc. (see include, but are not limited to, figures 5-7, 13-14). Hunter also discloses content provider, including operator, central controller, automatically downloads movies into the storage device and makes the movie available at the customer user stations such as displaying a cue "YOU'VE GOT FLICKS" (see include, but are not limited to, paragraph 0139-0142,0145). While first-in, first out protocol may be used for overwriting onto the hard drive of module 230, the customer catalog information may serve to establish a

different protocol that will overwrite the less likely to be purchased movies ahead of those recordings, which by analysis the module 340... Certain new release movies in high demand within the customer's primary area of interest may be designed to remain in storage for a minimum period of time, say one week, regardless of the "traffic" through storage module 230 (see include, but are not limited to, paragraph 0144).

Thus, metadata such as program title, time, or program type, etc. must be analyzed to determine when to make the movie available for viewing so that the cue "You've got new flicks" is displayed when the movie is available, or which movie to be deleted, remained in the storage due to less likely to be purchased, or high demand, etc. In addition, since Hunter discloses the content provider including operator, central controller control downloading of movies into the storage device of the customer stations, the movie data representing one or more movies stored on the set top box (user stations) is effectively removed at a time determined by the content provider (for example, in first-in, first out protocol, the movie stored in the storage is removed/overwritten at the time the content provider downloads another movie into the storage; or after a period (e.g., one week), determined by the content provider.

Appellant further argues Hunter teaches away from using metadata to determine when to remove a movie from store because Hunter discloses a "first-in, first out" write over protocol would permit each automatically downloaded movie to remain in storage module...(page 13, paragraph 1-page 14, paragraph 1). This argument is respectfully traversed.

As discussed above, Hunter discloses the content provider automatically downloads the movies into the storage at the user stations. The content stored in the storage is either overwritten as first in, first out protocol when the content provider downloads new movies or after a period of time (e.g., one week) determined by the content provider. When the content, which is automatically downloaded by the content provider, is available, a message "YOU'VE GOT NEW FLICKS" is displayed (see include, but are not limited to, paragraphs 0139-0142,0144,0147). Thus, the metadata must be used to determine when to remove a movie from stored so that the less likely purchase movie is overwritten or a particular movie remains in the storage regardless of the "traffic" through storage module and be removed after a predetermined period.

In addition, if the data is not used to determine a movie to be removed, how can the system determine the less likely purchased movie or high demand movie to be removed ahead of those recordings or after a minimum period of time?

A. With Regard To Claim 4 (and Its Dependent Claims Other Than 9), Hunter Does Not, Expressly or Inherently, Describe or Disclose "Permitting Analysis Of The Metadata To Determine When To Make The Movie Available For Viewing".

Appellant argues Hunter does not teach "permitting analysis of the metadata to determine when to make the movie available for viewing" (page 14, paragraph 2-page 15, line 2). This argument is respectfully traversed.

Hunter discloses the content provider provides movies information such as program title, type, time, etc. (see include, but are not limited to, figures 5-7, 13-15). The content provider, including operator, central controller, controls the download of movies, catalogs and other advertising or customer interest information into the storage device at the receiver (paragraphs 0139-0142, 0144, 0145, 0147). The content provider also controls the available time of the movies stored in the storage device (i.e. the customer catalog information may serve to establish a different protocol that will overwrite the less likely to be purchased movies ahead of those recording. Certain new release movies in high demand within the customer's primary areas of interest may be designated to remain in storage for a minimum period of time, say one week, regardless of the "traffic" through storage module 230 (paragraph 0144, lines 23-31). Hunter further discloses the graphical user interface alerts the customer that the recordings are available by a cue such as "You've got Flicks"(paragraph 0139). Thus, the metadata (e.g., release date, program title, time, information identified the program, etc.) must be analyzed to determine when to make the movie available for viewing so that a cue is displayed at predetermined point (i.e., when the recording are available) or particular movie is available within particular period (i.e. remain in storage for a week) regardless of "traffic" through storage module, or less likely purchased movie is overwritten ahead of those recordings.

If the metadata is not analyzed, how can the system know when to display the cue "You've got new Flicks" or when to overwrite less likely purchased movie, or to keep

a high demand movie in the storage of the user station for a predetermined period of time?

Therefore, Hunter inherently discloses "permitting analysis of the metadata to determine when to make the movie available for viewing".

B. With Regard to Claim 9, Hunter Does Not, Expressly or Inherently, Describe or Disclose "Repeatedly Re-Broadcasting Movie Data Thereby to Ensure That The Entire Movie Is Received By the Set-Top Box."

Appellant argues Hunter no mention of "re-broadcasting movie data" (page 15, paragraph 2). This argument is respectfully traversed.

Hunter discloses new release movies may be transmitted several times per day with concentration before and during prime evening viewing periods, each new release movie is transmitted every day on the hour from 4:30 p.m to 8:30 p.m, and at several other times daily (see include, but not limited to, paragraphs 0061, 0113, 0119). Thus, the limitation of "repeatedly re-broadcast movie data..." is interpreted as re-broadcasting popular movies (e.g. new release movie) several times per day, every day on hour from 4:30 pm to 8:39 pm and at several other times daily, or every 30 minutes from 5:30 p.m to 8:30 p.m. and as a result of repeatedly broadcasting popular movies server times a day, to entire movie is received by the set top box (user stations).

Therefore, Hunter inherently disclose "repeatedly re-broadcasting movie data thereby to ensure that the entire movie is received by the set top box."

C. With Regard to Claim 10 (and Its Dependent Claims other Than 11 and 15), Hunter Does Not, Expressly or Inherently, Describe or Disclose "Effecting Removal of The Movie Data Representing One or More Movie Stored On The Set Top Box at a time Determined by the Content Provider"

Appellant argues Hunter does not teach, inherently or otherwise, "effecting removal of the movie data representing one or more movies stored on the set top box at a time determined by the content provider" (page 16). This argument is respectfully traversed.

Hunter discloses content provider, including operator, central controller, automatically downloads movies into the storage device and makes the movie available at the customer user stations such as displaying a cue "YOU'VE GOT FLICKS" (see include, but are not limited to, paragraph 0139-0142,0145). Hunter additionally disclose while first-in, first out protocol may be used for overwriting onto the hard drive of module 230, the customer catalog information may serve to establish a different protocol that will overwrite the less likely to be purchased movies ahead of those recordings, which by analysis the module 340... Certain new release movies in high demand within the customer's primary area of interest may be designed to remain in storage for a minimum period of time, say one week, regardless of the "traffic" through storage module 230 (see include, but are not limited to, paragraph 0144). Since Hunter

discloses the content provider, including operator and central controller, controls downloading of movies into the storage device of the customer stations, the movie data representing one or more movies stored on the set top box (user stations) is effectively removed at a time determined by the content provider (for example, in first-in, first out protocol, the movie stored in the storage is removed/overwritten at the time the content provider downloads another movie into the storage; or after a period (e.g., one week), determined by the content provider.

Therefore, Hunter discloses "effecting removal of the movie data representing one or more movies stored on the set top box at a time determined by the content provider."

D. With Regard to Claim 15, Hunter Does Not, Expressly or Inherently, Describe or Disclose "repeatedly Re-Broadcasting Movie Data Thereby To Ensure That The Entire Movie Is Received by the Set Top Box" (page 17).

the argument corresponds to the argument in Section B, and the Examiner responses to this argument as discussed in section B above.

E. With Regard To Claim 18 (and Its Dependent Claims), Hunter Does Not, Expressly or Inherently, Describe or Disclose "Remotely Controlling When To Make Data Available For Viewing By The User; and Remotely Controlling When To Remove Data From The Set Top Box."

Appellant argues Hunter does not teach, inherently or otherwise, "remotely controlling when to make data available for viewing by the user, and remotely controlling when to remove data from the set top box" (page 17-18). This argument is respectfully traversed.

Hunter discloses the movies comprise information such as title, time, rating, type, etc. (see include, but are not limited to, figures 5-7, 13-14). Hunter also discloses content provider, including operator, central controller, automatically downloads movies into the storage device and makes the movie available at the customer user stations such as displaying a cue "YOU'VE GOT FLICKS" (see include, but are not limited to, paragraph 0139-0142,0145). While first-in, first out protocol may be used for overwriting onto the hard drive of module 230, the customer catalog information may serve to establish a different protocol that will overwrite the less likely to be purchased movies ahead of those recordings, which by analysis the module 340... Certain new release movies in high demand within the customer's primary area of interest may be designed to remain in storage for a minimum period of time, say one week, regardless of the "traffic" through storage module 230 (see include, but are not limited to, paragraph 0144). Thus, Hunter discloses "remotely controlling when to make data available for viewing by the user" (interpreted as the content provider remotely determine when to make data available for viewing by the user by automatically download the data to the user station, display an alert "YOU'VE GOT NEW FLICKS" when the movie is available or broadcast new movie to user or keeping high demand movie in storage for a

minimum period of time. The limitation “remotely controlling when to remove data from the set top box” is interpreted as the content provider remotely controlling when to remove data storage in the user station by broadcast new movie to remove old movie stored in the storage (in first-in, first out protocol) or overwrite less likely to be purchased movie ahead of recordings, or remove high demand movie after a predetermined period of time.

Therefore, Hunter discloses “remotely controlling when to make data available for viewing by the user, and remotely controlling when to remove data from the set top box”.

F. With Regard To Claim 23 (And Its Dependent Claims), Hunter Does Not, Expressly or Inherently, Describe or Disclose “Providing Software For Operating on the Remote Hardware Device to Process Metadata and Manage the Content According to It Associated Metadata”.

Hunter discloses the content provider controls the download of movies, catalogs and other advertising or customer interest information into the storage device at the receiver (paragraphs 0139-0142, 0145). The content provider also control the available time of the movies stored in the storage device (i.e. the customer catalog information may serve to establish a different protocol that will overwrite the less likely to be purchased movies ahead of those recording. Certain new release movies in high demand within

the customer's primary areas of interest may be designated to remain in storage for a minimum period of time, say one week, regardless of the "traffic" through storage module 230 (paragraph 0144, lines 23-31). Thus, a software must be included for operating at the remote hardware device (software for operation on the user stations) to analyze the metadata to determine when to make a movie available for viewing so that the cue is displayed at a predetermined time (when recording is available) or the movie remains in the storage at predetermined period, say one week, regardless of "traffic" through the storage, or less likely to be purchased movie is overwrite ahead of recordings (see also discussion in section A above).

Therefore, Hunter inherently discloses "providing software for operating on the remote hardware device to process metadata and manage the content according to its association metadata".

G. With Regard To Claim 26 (And Its Dependent Claims), Hunter Does Not, Expressly or Inherently, Describe or Disclose "Providing Software... To Analyze The Metadata To Determine When A Movie Should Be Made Available (pages 19-20).

The argument corresponds to Argument in Section A, and Examiner responses to the argument as discussed in Section A. Hunter further discloses movie is automatically downloaded, and removed, the message "YOU'VE GOT NEW FLICKS" is automatically

displayed when the movie is available (see include, but are not limited to, paragraphs 0139-0147). Thus, software must be used to perform these functions.

H. WITH REGARD TO CLAIM 30 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE “MAKING ONE OR MORE OF THE MOVIES AVAILABLE TO THE USER AT A TIME PREDETERMINED BY THE CONTENT PROVIDER”

Appellant argues Hunter does not teach, inherently or otherwise, “making one or more of the movies available to the user at a time predetermined by the content provider” (page 20). This argument is respectfully traversed.

Hunter discloses content provider, including operator, central controller, automatically downloads movies into the storage device and makes the movie available at the customer user stations such as displaying a cue “YOU’VE GOT FLICKS” (see include, but are not limited to, paragraph 0139-0142,0145). While first-in, first out protocol may be used for overwriting onto the hard drive of module 230, the customer catalog information may serve to establish a different protocol that will overwrite the less likely to be purchased movies ahead of those recordings, which by analysis the module 340... Certain new release movies in high demand within the customer’s primary area of interest may be designed to remain in storage for a minimum period of time, say one week, regardless of the “traffic” through storage module 230 (see include, but are not

limited to, paragraph 0144). Thus, the limitation “making one or more of the movies available to the user at a time predetermined by the content provider” is interpreted as the content provider, including operator and central controller, downloads the movies to the storage device at the user station and make it available to the user at a predetermined time such as every 30 minutes from 5:30 pm to 8:30 pm, and several other time daily (see include, but are not limited to, paragraphs 0061, 0113, 0119) or make it available to the user when it is displayed “YOU’VE GOT NEW FLICKS” or make it available during the time the movie is stored in the storage (e.g., one week), or make it available until it is overwritten by new downloaded movie.

Therefore, Hunter discloses “making one or more of the movie available to the user at a time predetermined by the content provider”

I. WITH REGARD TO CLAIM 37 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE “ANALYZING THE ASSOCIATION DATA TO DETERMINE WHEN THE MOVIES SHOULD BE MADE AVAILABLE FOR VIEWING” (page 21)

The argument corresponds to the argument in Section A, and the Examiner responses to the argument as discussed in the section A

J. WITH REGARD TO CLAIM 41 (AND ITS DEPENDENT CLAIMS OTHER THAN 78), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, “A PROCESSOR FOR EXECUTING SOFTWARE, PROCESSING DATA RECEIVED THROUGH THE ANTENNA AND TUNER, AND FOR PROCESSING USER INPUT COMMANDS TO PERMIT ACCESS TO THE STORED MOVIE DATA UNDER PREDETERMINED CONTROL CONDITIONS TO PERMIT ACCESS TO THE STORED MOVIE DATA UNDER PREDETERMINED CONTROL CONDITION DERIVED FROM THE METADATA.

Appellant argues Hunter does not teach, inherently or otherwise, “a processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions derived from the metadata” because there no discussion in Hunter of deriving control conditions from the metadata (page 22). This argument is respectfully traversed.

Hunter discloses the content provider controls the download of movies, catalogs and other advertising or customer interest information into the storage device at the receiver (paragraphs 0139-0142, 0145). The content provider also control the available time of the movies stored in the storage device (i.e. the customer catalog information may serve to establish a different protocol that will overwrite the less likely to be purchased movies ahead of those recording. Certain new release movies in high demand within the customer’s primary areas of interest may be designated to remain in

storage for a minimum period of time, say one week, regardless of the "traffic" through storage module 230 (paragraph 0144, lines 23-31). Hunter also discloses new code keys for every distributed movie transmitted via phone/modem that allow the user to access encoded/encrypted stored movies (paragraphs 0015-0016, 0079, 0081-0096). Hunter further discloses the movies provided to the user and stored in the storage are based on metadata of content such as type of content (e.g., new release, movies), program title, time, etc. (see include, but are not limited to, paragraphs 0061, 0113, 0139-0147). Thus, the stored movie data is permitted to access under predetermined control conditions derived from metadata (e.g. the stored movie is make available to the user under predetermined conditions from metadata such as code keys, only at time when the recording is available, every 30 minutes, when the cue "You've got new flicks" is displayed, etc.). Hunter further discloses processor for executing software, processing data received from the antenna and tuner... as discussed in the rejection of claim 41 and section F above.

Therefore, Hunter discloses "a processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions derived from the metadata."

K. WITH REGARD TO CLAIM 52 9AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE

“ANALYZING OF THE METADATA TO DETERMINE WHEN TO MAKE THE MOVIE AVAILABLE FOR VIEWING” (pages 22-23).

The argument corresponds to the argument in Section I, and the Examiner responses to the argument as discussed in the section I.

L. WITH REGARD TO CLAIM 59, HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, “STORING FOR A PREDETERMINED TIME ON THE SET TOP BOX THE MOVIE DATA BROADCAST FROM THE CONTENT PROVIDER ONTO THE SET TOP BOX, THE PREDETERMINED TIME BEING ESTABLISHED BY THE CONTENT PROVIDER” (pages 23-24)

The argument corresponds to the argument in Section C, and the Examiner responses to the argument as discussed in the section C.

M. WITH REGARD TO CLAIM 72 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, “PERMITTING ANALYSIS OF THE METADATA TO DETERMINE WHEN TO MAKE THE VIDEO AVAILABLE FOR VIEWING” (page 24)

Art Unit: 2623

The argument corresponds to the argument in Section A, and the Examiner responses to the argument as discussed in the section A (Also see discussion in the rejection of claim 72).

N. WITH REGARD TO CLAIM 83 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, "THE METADATA BEING UTILIZED BY THE SET TOP BOX TO DELETE THE CONTENT" (page 25)

The argument corresponds to the argument in Section C, and the Examiner responses to the argument as discussed in the section C (Also see discussion in the rejection of claim 83).

O. WITH REGARD TO CLAIM 88 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, "THE METADATA BEING UTILIZED BY THE SET TOP BOX TO DELETE THE CONTENT" (pages 25 -26)

The argument corresponds to the argument in Section C, and the Examiner responses to the argument as discussed in the section C (please also see discussion in the rejection of claim 88).

P. WITH REGARD TO CLAIM 91 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, “THE METADATA BEING UTILIZED BY THE SET TOP BOX TO DELETE THE CONTENT” (pages 25 -26).

The argument corresponds to the argument in Section C, and the Examiner responses to the argument as discussed in the section C, wherein the element “content unavailable to a user” is interpreted as to delete the content, and after the content is deleted, it is unavailable to user (please also see discussion in the rejection of claim 91).

Q. WITH REGARD TO CLAIM 95 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, “ANALYZING EACH OF THE SETS OF METADATA TO DETERMINE IF THE SET OF METADATA MEETS PRE-DETERMINED CRITERIA ESTABLISHED BY THE CONTENT PROVIDER FOR DISPLAYING THE MOVIE ASSOCIATED WITH THE SET OF METADATA IN A LISTING OF AVAILABLE MOVIES FOR VIEWING IN A USER INTERFACE ASSOCIATED WITH THE SET TOP BOX” (page 28).

The argument corresponds to the argument in Section A and section H, and the Examiner responses to the argument as discussed in the section C and section H. (please also see discussion in the rejection of claim 95).

R. WITH REGARD TO CLAIM 98 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE, “ESTABLISHING PRE-DETERMINED CRITERIA THAT DETERMINE WHETHER CONTENT SHOULD BE DISPLAYED... AND TRANSMITTING THE METADATA TO THE SET TOP BOX SO THAT THE METADATA IS ANALYZED TO DETERMINE IF THE PRE-DETERMINED CRITERIA IS MET, THE CONTENT BEING MADE AVAILABLE FOR VIEWING IF THE PREDETERMINED CRITERIA IS MET” (page 29).

The argument corresponds to the argument in Sections A, H and L, and the Examiner responses to the argument as discussed in the sections A, H, and L. (please also see discussion in the rejection of claim 98).

2. THE APPLIED DOCUMENTS, ALONE OR IN COMBINATION, DO NOT DISCLOSE EACH AND EVERY ELEMENT OF REJECTED CLAIM 11. ADDITIONALLY, THERE IS NO EVIDENCE OF A SUGGESTION OR MOTIVATION TO COMBINE THE APPLIED DOCUMENTS (pages 30-31).

Appellant argues Hunter does not disclose, inherently or otherwise, all of the elements of the base claim of claim 11. For example, Hunter does not disclose “effecting removal

of the movie data ..." as recited in Assignee's claim 10 (page 30, paragraph 2). This argument is respectfully traversed.

Hunter discloses "effecting removal of movie data..." as discussed in the rejection of claim 10 and in section C above. Also, as discussed in the rejection of claim 11, it would have been obvious to one of ordinary skill in the art to store the movie at any time period before making the movie available. Therefore, the incorporation of teaching that would have been obvious to one of ordinary skill in the art at the time the invention was made disclose all elements of claim 11.

In response to applicant's argument that there is no suggestion or teaching or motivation to combine the references (page 31, paragraph 2), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hunter discloses that modifications may be made to the illustration embodiments (paragraph 0218). Hunter also discloses the movies are downloaded and stored in the storage device before displayed to the user (see include, but are not limited to, paragraphs 0139, 0144). Thus, Hunter suggests modifications to

the illustrated embodiments. The motivation to combine the references in this case is found in the knowledge generally available to one of ordinary skill in the art.

Therefore, rejection of claim 11 under 103 is properly applied.

3. THE APPLIED DOCUMENTS, ALONE OR IN COMBINATION, DO NOT DISCLOSE EACH AND EVERY ELEMENT OF REJECTED CLAIMS 43-48. ADDITIONALLY, THERE IS NO EVIDENCE OF A SUGGESTION OR MOTIVATION TO COMBINE THE APPLIED DOCUMENTS.

Appellant argues Hunter does not disclose, inherently or otherwise, all of the elements of the base claim of claims 43-48. For example, Hunter does not disclose "control conditions derived from the metadata," as recited in Assignee's claim 43 (page 32, paragraph 2). This argument is respectfully traversed.

Hunter discloses "control condition derived from the metadata" as discussed in the rejection of claim 43 and in section J above. Therefore, the combination of Hunter and Maruo discloses all elements of claims 43-48 (see also discussion in the rejection of claims 43-48).

In response to applicant's argument that there is no suggestion or teaching or motivation to combine the references (page 32 –page 33, bridge paragraph), the

examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the knowledge generally available to one of ordinary skill in the art. In particular, Hunter discloses a system that provide video program (i.e. movie) to a receiving device, and user selects a video program to view (see include, but not limited to, figures 4,11,15). Hunter also discloses that modifications may be made to the illustration embodiments (paragraph 0218).

Maruo also discloses a system that provide video program to a receiving device, and user select a video program to view (see include, but not limited to, figures 4, 5a,7, col. 7, lines 5-13, col. 8, lines 47-62). Maruo's disclosure of smart card... reads on "a smart card secured to a circuit board of the receiver" and smart card facilitates a dedicated use of the receiver with a designated user as discussed in page 29 of the Final Office Action, dated 04/21/2006. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hunter to use the teaching as taught by Maruo in order to improve convenience for user to pay the bill and reduce unauthorized user to access pay per view program, thereby reduce lost in revenue.

Therefore, the combination of Hunter and Maruo discloses all elements of the claims, and the combination of the references is properly applied.

4. THE APPLIED DOCUMENTS, ALONE OR IN COMBINATION, DO NOT DISCLOSE EACH AND EVERY ELEMENT OF REJECTED CLAIM 78. ADDITIONALLY, THERE IS NO EVIDENCE OF A SUGGESTION OR MOTIVATION TO COMBINE THE APPLIED DOCUMENTS.

Appellant argues Hunter does not disclose, inherently or otherwise, all of the elements of the base claim of claim 78. Claim 78 depends from claim 41 (page 34, paragraph 2). This argument is respectfully traversed.

Hunter discloses all elements of claim 41 as discussed in the rejection of claim 41 and in Section J above. Hunter in view of Dodson also discloses all elements of claim 78 as discussed in the rejection of claim 78.

In response to applicant's argument that there is no suggestion or teaching or motivation to combine the references (page 34 –page 35, bridge paragraph), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

Art Unit: 2623

themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is either found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In particular, Hunter discloses a system that provide video program (i.e. movie) to a receiving device, and user selects a video program to view (see include, but not limited to, figures 4,11,15). Hunter also discloses that modifications may be made to the illustration embodiments (paragraph 0218).

Dodson also discloses a system that provides video program to a receiving device, and user selects a video program to view (see include, but not limited to, figure 2). Dodson further discloses a controller simultaneously plays a video being displayed on the TV and reacts to signals from a remote control (206), and modem activity (e.g. Internet interface 106) - see figure 1-8, col. 2, line 46-col. 3, line 28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hunter to use the teaching as taught by Dodson in order to immediately provide additional information to a user (col. 1, lines 40-55), allow user to simultaneously watch the program and additional information on the same screen.

Therefore, the combination of Hunter and Dodson discloses all elements of the claim, and the combination of the references is properly applied

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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